UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,479	07/09/2001	L. Carlton Brown JR.	006969-022311US	7465

20350 7590 01/07/2009

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER	
ERB, NATHAN	

ART UNIT	PAPER NUMBER
3628	

MAIL DATE	DELIVERY MODE
01/07/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/902,479	BROWN ET AL.	
	Examiner	Art Unit	
	NATHAN ERB	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 September 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10 and 12-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10 and 12-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Applicant's response to Office action was received on September 10, 2008.

3. In response to Applicant's amendment of the claims, all of the claim rejections under 35 U.S.C. 112, second paragraph, from the previous Office action are hereby withdrawn.

4. Please note the new claim rejections under 35 U.S.C. 103 below in this Office action.

Claim Rejections - 35 USC § 103

5. Claims 1-4, 8-9, 25, 27-28, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara et al., U.S. Patent No. 6,249,777 B1 (hereinafter referred to as Kara 1), in view of Goldberg et al., U.S. Patent No. 5,848,401, in further view of Kara, U.S. Patent No. 6,505,179 B1 (hereinafter referred to as Kara 2).

As per **Claims 1 and 25**, Kara 1 discloses:

- a method (or system) for obtaining a postage stamp by a user system, comprising a processor (coupled to memory), a memory, and a printer, from a website (or central) server over a communications network (column 1, lines 21-32; column 6, lines 12-38; column 7, lines 4-19; column 8, lines 24-52; user system stores Demand program, so it must have a memory);

- requesting said stamp from said website (or central) server over the Internet (in a markup language format) (column 1, lines 21-32; column 6, lines 12-38; column 8, lines 24-52; HTML is a markup language);

- receiving a markup language message over the Internet (in response to said user request) comprising encoded binary data representing a machine-readable portion of an indicium associated with said stamp, said indicium comprising a digital signature (column 1, lines 21-32; column 6, lines 12-38; column 8, lines 24-52; column 13, line 59, through column 14, line 2; column 17, lines 12-30; HTML is a markup language; computers transmit information in the form of encoded binary data);

- verifying that a user is an authorized user (column 8, lines 53-67);

- receiving a print program from said website server over the Internet (column 4, lines 7-37; column 6, lines 12-38; column 8, lines 24-52; JAVA);

- using said print program, printing said machine-readable portion on a label by said printer (wherein said print program is configured to permit the printing of the label on the printer) (column 4, lines 7-37; column 13, line 59, through column 14, line 2);

- a software module stored in said memory for extracting an indicium from the markup language message ((column 1, lines 21-32; column 6, lines 12-38; column 8, lines 24-52; column 13, line 59, through column 14, line 2; column 17, lines 12-30; HTML is a markup language; software module is Demand program);

- a software module stored in said memory for extracting a print program from said markup language message received over the Internet in response to said user

request (column 1, lines 21-32; column 4, lines 7-37; column 6, lines 12-38; column 8, lines 24-52; JAVA; HTML is a markup language).

Kara 1 fails to disclose wherein a label is a pre-processed label with a serial number. Goldberg et al. discloses wherein a label is a pre-processed label with a serial number (column 2, lines 10-20; column 7, lines 12-35; pre-printed label). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara 1 such that a label is a pre-processed label with a serial number, as disclosed by Goldberg et al. Motivation is provided by Goldberg et al. in that using pre-printed postage labels helps prevent postal fraud because the supply of pre-printed postal labels can be controlled (column 2, lines 10-20).

Kara 1 fails to disclose verifying that a number of a medium on which the stamp is to be printed is an authorized number. Kara 2 discloses verifying that a number of a medium on which the stamp is to be printed is an authorized number (column 2, lines 16-45; column 2, lines 46-63; column 4, line 19, through column 5, line 22; column 8, lines 16-29). It would have been obvious to one of ordinary skill in the art to modify the invention of Kara 1 such that it verifies that a number of a medium on which the stamp is to be printed is an authorized number, as disclosed by Kara 2, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **Claim 2**, Kara 1 further discloses wherein said print program is downloaded from said website server and stored in said memory (column 4, lines 7-37; column 6, lines 12-38; JAVA; user system stores Demand program, so it must have a memory).

As per **Claims 3 and 27**, Kara 1 further discloses wherein said markup language includes a Standard Generalized Markup Language (SGML) (column 6, lines 30-38; HTML is an application of SGML).

As per **Claims 4 and 28**, Kara 1 further discloses wherein said markup language includes a Hypertext Markup Language (HTML) (column 6, lines 30-38).

As per **Claim 8**, Kara 1 further discloses wherein said print program does not require a license from the United States Postal Service to execute (no mention of such a licensing requirement in entire reference).

As per **Claim 9**, Kara 1 further discloses wherein said print program does not require a separate account from the United States Postal Service to execute (no mention of such an account requirement in entire reference).

As per **Claim 31**, Kara 1 further discloses wherein said indicium further comprises a serial number (column 4, lines 7-37).

As per **Claim 32**, Kara 1 fails to disclose wherein said pre-processed label has the security feature of individual label serial number. Goldberg et al. discloses wherein said pre-processed label has the security feature of individual label serial number (column 2, lines 10-20; column 7, lines 12-35). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara 1 such that said pre-processed label has the security feature of individual label serial number, as disclosed by Goldberg et al. Motivation is provided by Goldberg et al. in that a serial number that identifies a pre-processed label can be used to deter fraudulent printing (column 2, lines 10-20; column 7, lines 12-35).

6. Claims 5, 10, 12-13, 15-16, 18-19, 21-24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara 1 in view of Goldberg et al. in further view of Kara 2 in further view of Meyer et al., U.S. Patent No. 6,915,271 B1.

As per **Claims 5 and 26**, Kara 1 fails to disclose wherein said markup language includes an eXtensible Markup Language (XML). Meyer et al. discloses wherein said markup language includes an eXtensible Markup Language (XML) (column 53, lines 9-19). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara 1 such that said markup language includes an eXtensible Markup Language (XML), as disclosed by Meyer et al.

Motivation is provided by Meyer et al. in that XML provides more flexibility for designing web pages than HTML (column 53, lines 9-19).

As per **Claims 10 and 22**, Kara 1 discloses:

- a method (or a computer program product stored in a computer readable medium) for obtaining a postage stamp by a user system, comprising a processor, a memory, and a printer, from a website server over a communications network (column 1, lines 21-32; column 4, lines 7-37; column 6, lines 12-38; column 7, lines 4-19; column 8, lines 24-52; user system stores Demand program, so it must have a memory; computer program product is Demand program);

- verifying that a user is an authorized user (column 8, lines 53-67);

- storing a print program downloaded from said website server over the Internet in said memory (column 4, lines 7-37; column 6, lines 12-38; column 8, lines 24-52; JAVA; user system stores Demand program, so it must have a memory);

- (code for) requesting said stamp from said website server over the Internet (column 1, lines 21-32; column 6, lines 12-38; column 8, lines 24-52);

- (code for) receiving a message over the Internet comprising encoded binary data representing a machine-readable portion of an indicium associated with said stamp, said indicium comprising a digital signature (column 1, lines 21-32; column 6, lines 12-38; column 8, lines 24-52; column 13, line 59, through column 14, line 2; column 17, lines 12-30; computers transmit information in the form of encoded binary data);

- code for receiving a print program from said website server over the Internet (column 4, lines 7-37; column 6, lines 12-38; column 8, lines 24-52; JAVA);

- (code for) using said print program, printing said machine-readable portion on a label by said printer (column 4, lines 7-37; column 13, line 59, through column 14, line 2).

Kara 1 fails to disclose wherein a label is a pre-processed label with a serial number. Goldberg et al. discloses wherein a label is a pre-processed label with a serial number (column 2, lines 10-20; pre-printed label). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara 1 such that a label is a pre-processed label with a serial number, as disclosed by Goldberg et al. Motivation is provided by Goldberg et al. in that using pre-printed postage labels helps prevent postal fraud because the supply of pre-printed postal labels can be controlled (column 2, lines 10-20).

Kara 1 fails to disclose verifying that a number of a medium on which the stamp is to be printed is an authorized number. Kara 2 discloses verifying that a number of a medium on which the stamp is to be printed is an authorized number (column 2, lines 16-45; column 2, lines 46-63; column 4, line 19, through column 5, line 22; column 8, lines 16-29). It would have been obvious to one of ordinary skill in the art to modify the invention of Kara 1 such that it verifies that a number of a medium on which the stamp is to be printed is an authorized number, as disclosed by Kara 2, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of

ordinary skill in the art would have recognized that the results of the combination were predictable.

Kara 1 fails to disclose wherein a message is an XML message. Meyer et al. discloses wherein a message is an XML message (column 53, lines 9-19). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara 1 such that a message is an XML message, as disclosed by Meyer et al. Motivation is provided by Meyer et al. in that XML provides more flexibility for designing web pages than HTML (column 53, lines 9-19).

As per **Claims 12 and 23**, Kara 1 fails to disclose communicating using an XML data structure. Meyer et al. further discloses communicating using an XML data structure (column 53, lines 9-19). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara 1 such that it communicates using an XML data structure, as disclosed by Meyer et al. Motivation is provided by Meyer et al. in that XML provides more flexibility for designing web pages than HTML (column 53, lines 9-19).

As per **Claim 13**, Kara 1 further discloses submitting information in a postage request (column 9, lines 1-15). Kara 1 fails to disclose wherein information is a serial number that identifies said pre-processed label. Goldberg et al. discloses wherein information is a serial number that identifies said pre-processed label (column 2, lines 10-20; column 7, lines 12-35). It would have been obvious to one of ordinary skill in the

art at the time of applicant's invention to modify the invention of Kara 1 such that information is a serial number that identifies said pre-processed label, as disclosed by Goldberg et al. Motivation is provided by Goldberg et al. in that a serial number that identifies a pre-processed label can be used to deter fraudulent printing (column 2, lines 10-20; column 7, lines 12-35).

As per **Claim 15**, Kara 1 fails to disclose wherein a program is downloaded only once. However, that element/limitation was well-known to one of ordinary skill in the art at the time of applicants' invention. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara 1 such that the print program is downloaded only once; in doing so, a program would be downloaded only once, as was well-known in the art at the time of applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicants' invention that downloading a program only once and saving it to one's computer saves time by avoiding having to download the program again when it is needed in the future.

As per **Claim 16**, Kara 1 further discloses wherein said print program is downloaded each time a user logs into said website server (column 4, lines 7-37; column 6, lines 13-38; column 8, lines 53-67; JAVA).

As per **Claim 18**, Kara 1 fails to disclose wherein said pre-processed label has the security feature of individual label serial number. Goldberg et al. discloses wherein said pre-processed label has the security feature of individual label serial number (column 2, lines 10-20; column 7, lines 12-35). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara 1 such that said pre-processed label has the security feature of individual label serial number, as disclosed by Goldberg et al. Motivation is provided by Goldberg et al. in that a serial number that identifies a pre-processed label can be used to deter fraudulent printing (column 2, lines 10-20; column 7, lines 12-35).

As per **Claims 19 and 24**, Kara 1 further discloses wherein the message further comprises a meter number, a (postal) rate class, and an amount of postage (column 4, lines 7-37; column 13, lines 41-50; column 17, lines 12-30).

As per **Claim 21**, Kara 1 further discloses using said print program, printing said meter number on said label by said printer; using said print program, printing said rate class on said label by said printer; and using said print program, printing said amount of postage on said label by said printer (column 4, lines 7-37; column 13, lines 41-50; column 17, lines 12-30).

7. Claims 6 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara 1 in view of Goldberg et al. in further view of Kara 2 in further view of Kramer et al., U.S. Patent No. 6,163,772.

As per **Claims 6 and 29**, Kara 1 fails to disclose wherein said print program (or software module) includes an ActiveX control. Kramer et al. discloses wherein said print program (or software module) includes an ActiveX control (column 13, lines 22-42). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara 1 such that said print program (or software module) includes an ActiveX control, as disclosed by Kramer et al. Motivation is provided by Kramer et al. in that ActiveX controls enable parts of software to be embedded in web pages (column 13, lines 22-42).

8. Claims 7 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara 1 in view of Goldberg et al. in further view of Kara 2 in further view of Gravell et al., U.S. Patent No. 6,098,058.

As per **Claims 7 and 30**, Kara 1 fails to disclose wherein said print program (or software module) includes a dynamic link library (dll) file. Gravell et al. discloses wherein said print program (or software module) includes a dynamic link library (dll) file (column 6, line 52, through column 7, line 6; column 8, lines 15-24; column 9, lines 11-31). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara 1 such that said print program (or software module) includes a dynamic link library (dll) file, as disclosed by Gravell et al. Motivation is provided by Gravell et al. in that a dll file can be used to perform postal metering functions, in particular, preventing the printing of postal indicia without proper

payment accounting (column 6, line 52, through column 7, line 6; column 8, lines 15-24; column 9, lines 11-31).

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kara 1 in view of Goldberg et al. in further view of Kara 2 in further view of Meyer et al. in further view of Kramer et al.

As per **Claim 14**, Kara 1 fails to disclose wherein said print program includes an ActiveX control. Kramer et al. discloses wherein said print program includes an ActiveX control (column 13, lines 22-42). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara 1 such that said print program includes an ActiveX control, as disclosed by Kramer et al. Motivation is provided by Kramer et al. in that ActiveX controls enable parts of software to be embedded in web pages (column 13, lines 22-42).

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kara 1 in view of Goldberg et al. in further view of Kara 2 in further view of Meyer et al. in further view of Hind et al., U.S. Patent No. 6,978,367 B1.

As per **Claim 17**, Kara 1 fail to disclose wherein said encoded binary data is base 64. Hind et al. discloses wherein said encoded binary data is base 64 (column 26, lines 21-32). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara 1 such that said encoded binary

data is base 64, as disclosed by Hind et al. Motivation is provided by Hind et al. in that base 64 is a well-known option for encrypting data (column 26, lines 21-32).

11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kara 1 in view of Goldberg et al. in further view of Kara 2 in further view of Meyer et al. in further view of Kara 3, U.S. Patent No. 6,233,568 B1.

As per **Claim 20**, Kara 1 fails to disclose using a microprint line. Goldberg et al. discloses using a microprint line (column 6, lines 60-65; column 7, lines 12-35). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara 1 such that it uses a microprint line, as disclosed by Goldberg et al. Motivation is provided by Goldberg et al. in that microprint acts as a security feature (column 6, lines 60-65; column 7, lines 12-35).

Kara 1 fails to disclose using a logo in postal indicia. Kara 3 discloses using a logo in postal indicia (column 12, lines 43-48; column 23, lines 17-21). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara 1 such that it uses a logo in postal indicia, as disclosed by Kara 3. Motivation is provided by Kara 3 in that using a logo in postal indicia allows the indicia to be personalized (column 12, lines 43-48; column 23, lines 17-21).

Conclusion

12. **Examiner's Note:** Examiner has cited particular portions of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific

limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Erb whose telephone number is (571) 272-7606. The examiner can normally be reached on Mondays through Fridays, 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nathan Erb
Examiner
Art Unit 3628

Nhe

/Igor N. Borissov/
Primary Examiner, Art Unit 3628